

REMARKS

Claims 21-25 are pending in this application. By this Amendment, claim 22 is amended to correct a discrepancy in this claim in the resubmitted Preliminary Amendment filed on March 18, 2002 (mainly, that the "characterized in that" clause in the claim was shown to be replaced with "wherein" in the Appendix of the Preliminary Amendment, but the actual claim 22 in the body of the Preliminary Amendment inadvertently did not reflect this change). Further, new dependent claim 25 is added.

No new matter is added by this Amendment. Support for new claim 25 is found in the present specification, for example at the top of page 10.

In the Office Action, claims 21-24 were rejected under 35 U.S.C. §112, first paragraph, allegedly because the specification was not enabling for the claimed cord. In particular, the Patent Office alleged that the specification does not enable a person skilled in the art to make the invention commensurate in scope with the claims. This rejection is respectfully traversed.

This rejection is based upon the "how to make" prong of the enablement requirement of 35 U.S.C. §112, first paragraph. The test of enablement in this regard is whether one reasonably skilled in the art could make the claimed invention, without undue experimentation, from the disclosure in the specification. Applicants respectfully submit that the present specification contains more than sufficient information to have enabled one of ordinary skill in the art to have made the cord comprising polyester filaments recited in claims 21-24 without undue experimentation.

Significant in this regard is the fact that the Office Action itself acknowledges that the specification is "enabling for a cord made from the inventive polyester yarn having a particular breaking tenacity, elongation at break, and breaking toughness...". Thus, the Patent Office recognizes that one of ordinary skill in the art would have been enabled to have made

the claimed cord having the recited properties from the polyester filament described in the specification. That is, the Patent Office acknowledges that the present specification properly enables at least one method for making the claimed cord having the recited properties, this method being one in which the cord is made from the polyester filaments having properties described in the specification.

Applicants respectfully submit that this acknowledgment by the Patent Office confirms that the cord recited in claim 21 is in fact fully enabled by the present specification in accordance with the requirements of 35 U.S.C. §112, first paragraph. As explained in MPEP §2164.01(b), "as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. §112 is satisfied," citing In re Fischer, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). This section of the MPEP continues that "failure to disclose other methods by which the claimed invention may be made does not render the claim invalid under 35 U.S.C. §112," citing Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743, (Fed. Cir. 1987), cert. denied, 484 U.S. 954 (1987).

In view of this established case law, Applicants respectfully submit that the assertion in the Office Action that the claimed cord is not enabled because "the only originally disclosed way to obtain the claimed cord properties is by making the cord from the inventive polyester yarn, and it does not appear that one of ordinary skill in the art would know any other way to make the claimed cord" is improper and does not form a proper basis to assert that the presently claimed cord is not enabled by the specification. In other words, the case law makes it clear that it is not necessary for the specification to provide any other than at least one way to make the claimed invention, which the Patent Office acknowledges has been

done in the present specification. 35 U.S.C. §112, first paragraph does not require that the specification set forth other or all possible ways to make a claimed invention.

For completeness, Applicants point out that the present specification sufficiently describes the materials to use for the polyester filament, sufficiently describes the properties and methods of making the polyester filament, and sufficiently describes making the claimed cord from the polyester filaments, in order to achieve the entire scope of the invention recited in claim 21. That is, the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, thereby satisfying the enablement requirement of 35 U.S.C. §112 (*In re Fischer, supra*).

Moreover, the specification includes several working examples that can be followed to derive the claimed invention, thereby eliminating the need for one of ordinary skill in the art to undertake undue experimentation to make the claimed cord.

In view of the description in the specification, Applicants respectfully submit that one of ordinary skill in the art would have been enabled to have made the claimed cord without undue experimentation. Accordingly, the requirements of 35 U.S.C. §112, first paragraph have been met.

For at least the foregoing reasons, Applicants respectfully submit that claims 21-25 are enabled by the present specification in accordance with the requirements of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of this rejection are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 21-25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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